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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,012

09/09/2003

Stephen J. Miller

T-6012

3488

34014 7590 07/12/2007

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EXAMINER

DOUGLAS, JOHN CHRISTOPHER

ART UNIT

PAPER NUMBER

1764

MAIL DATE

DELIVERY MODE

07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,012

Applicant(s)

MILLER ET AL.

Examiner

John C. Douglas

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/2007 has been entered.

Response to Amendment

Examiner acknowledges the submission filed on 2/26/2007 containing remarks and amendments to the claims. Examiner acknowledges claim 1 as amended.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 5, and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fragelli (US 6103101).
2. With respect to claims 1, 3 and 7-9, Fragelli discloses producing a bright stock from a feed comprising a hydrocracked residuum that contains 34 ppm of nitrogen and 0.91% sulfur that is subjected to hydroisomerization and hydrocracking that is subjected to a deep cut distillation at greater than 545 degrees C (1013 F) to produce a bright stock with a viscosity measured at 100 degrees C of 24.22 cSt having a viscosity index

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of 106 (see Fragelli, column 6, lines 8-24, column 8, lines 28-39, column 10, lines 1-65, and Tables 1 and 2).

Fragelli does not disclose where the distillation occurs before the reaction zone. However, according to *In re Burhans*, 154 F.2d 690 (CCPA 1946), the selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results (see MPEP 2144.04 IV. C.). The placement of the distillation step after the reaction step instead of before the reaction step is a reversal in the order of the prior art process of Fragelli. Thus, it would have been obvious to perform the distillation step prior to the reaction step because such a change is simply a reversal in the order of process steps.

3. With respect to claim 2, Fragelli discloses where the feed can be a deasphalted oil (see Fragelli, column 2, lines 56-67).

4. With respect to claim 5, Fragelli discloses where a final bed of catalyst is a hydrofinishing catalyst (see Fragelli, column 8, lines 28-40).

5. With respect to claims 10-12, Fragelli discloses where a catalyst can be ZSM-23 (see Fragelli, column 2, lines 5-11).

6. With respect to claims 13-15, Fragelli discloses where the catalyst contains platinum (see Fragelli, column 7, lines 14-30).

7. Claims 4 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fragelli in view of Baker (US 5951848). Fragelli does not disclose a feed where the sulfur is less than 0.9 wt % and the nitrogen is less than 34 ppm.

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However, Baker discloses feed to the isomerization zone with a nitrogen concentration of less than 0.5 ppm and a sulfur concentration of 7 ppm (see Baker, Table 2).

Baker discloses that the feed was upgraded by hydrocracking prior to dewaxing because high nitrogen and sulfur levels result in unacceptably low catalyst life (see Baker, column 7, lines 40-52 and column 10, lines 59-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Miller to include feed to the isomerization zone with a nitrogen concentration of less than 0.5 ppm and a sulfur concentration of 7 ppm in order to preserve catalyst life.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fragelli in view of Miller (US 4657661). Fragelli does not disclose contacting the stabilized lubricant bright stock with clay in a clay treatment zone.

However, Miller discloses treating the bright stock with acidic clay (see Miller, column 5, lines 54-68).

Miller discloses that acidic clays are the preferred catalysts for further stabilizing the bright stock (see Miller, column 6, lines 3-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Fragelli to include treating the bright stock with acidic clay in order to use the preferred catalyst for stabilizing bright stock.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Douglas whose telephone number is 571-272-1087. The examiner can normally be reached on 7:30 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCD

7/1/2007



Glenn Caldarola
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